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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/995,277      | 11/26/2001  | Jonathan B. Baill    | 4102-5-1            | 3236             |

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EXAMINER

SPIVACK, PHYLLIS G

ART UNIT

PAPER NUMBER

1614

DATE MAILED: 08/18/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

|                                       |                                     |
|---------------------------------------|-------------------------------------|
| Application No.<br><b>09/995,277</b>  | Applicant(s)<br><b>Baell et al.</b> |
| Examiner<br><b>Phyllis G. Spivack</b> | Art Unit<br><b>1614</b>             |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on May 27, 2003

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4)  Claim(s) 108-111, 113, 116, 122-134, 136-140, 142, and 145 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) 122-128, 132, 134, 136-140, 142, and 145 is/are allowed.

6)  Claim(s) 108-111, 113, 116, 129, and 131 is/are rejected.

7)  Claim(s) 130 and 133 is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6)  Other: \_\_\_\_\_

Art Unit: 1614

Applicants' Amendment filed May 27, 2003, Paper No. 12, is acknowledged. Claims 112, 114, 115, 117-121, 135, 141, 143, 144 and 146-150 are canceled. Claims 108-111, 113, 116, 122-140, 142 and 145 remain under consideration wherein no heteroaryl groups are present.

Claims 108-112 and 122-141 remained rejected in the last Office Action under judicially created doctrine as being drawn to an improper Markush group.

Following the cancellation of claim 135 and the deletion of the heteroaryl option in claim 122, this rejection of record is withdrawn.

Claims 122-134 and 136-142 remained rejected under 35 U.S.C. 112, both first and second paragraphs, in the last Office Action.

Subsequent to the amendments to claim 122 and the cancellation of claim 141, these rejections of record are withdrawn.

Claims 108-112 were rejected under 35 U.S.C. 102(b) as being anticipated by Chucholowski et al., U.S. Patent 5,521,160, in the last Office Action. It was asserted Chucholowski teaches pharmaceutical compositions comprising bis-carboxystilbenes.

Applicants argue the disclosed carboxystilbenes only form a part of the final compounds taught by Chucholowski, which are sulphuric acid esters of sugar alcohols. The final compounds, Applicants urge, are useful for treating atherosclerosis and not for modulating Fc receptor binding. Applicants argue the carboxystilbenes are residues of formula (a).

Art Unit: 1614

The rejection is withdrawn because, as amended, the compounds disclosed by Chucholowski are no longer encompassed any compositions comprising compounds of the formula of instant claim 108.

In the last Office Action claims 108-111, 113 and 116 were rejected under 35 U.S.C. 103 as being unpatentable over Yanaka et al., U.S. Patent 5,932,575. It was asserted Yanaka teaches a pharmaceutical composition comprising a compound of formula I, 3,3'-[oxybis(methylene)]bis-benzoic acid, BRI 6727, the compound of instant claim 116, for use in the treatment of cardiac diseases.

Applicants argue Yanaka relates to agents for treating cardiac diseases, not immune diseases. Further, Applicants urge Yanaka does not describe the actual production of the compounds of the present invention.

Applicants' arguments have been given careful consideration but are not found persuasive. Applicants' arguments are primarily directed to the intended use of the claimed composition. However, intended use confers no patentable weight to composition claims. See In re Hack, 114 USPQ 161. The actual production of BRI 6727 is not required. The compound is encompassed in Yanaka's definition of the compounds of his formula I. Accordingly, in view of Yanaka's teaching, one skilled in the cardiology art would have been motivated to prepare and administer a composition comprising 3-[(m-carboxyphenyl)methoxy]benzoic acid to treat various cardiac diseases. The recitation "vasculitities" encompasses various diseases of the vascular system.

Art Unit: 1614

The rejection of composition claims 108-111, 113 and 116 under 35 U.S.C. 102 is maintained and is presently extended to include method claims 129 and 131.

Claims 122-128, 130, 132-134, 136-140, 142 and 145 appear to be free of the prior art.

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C FR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Phyllis Spivack at telephone number 703-308-4703.

August 15, 2003



PHYLLIS SPIVACK  
PRIMARY EXAMINER